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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,002	02/20/2004	Arja Miettinen-Oinonen	1716.051000A	5790

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

MAIL DATE	DELIVERY MODE
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07/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/782,002	Applicant(s) MIETTINEN-OINONEN ET AL.	
	Examiner Manjunath N. Rao, Ph.D.	Art Unit 1652	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: 31.
 Claim(s) rejected: 32-122.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

Manjunath N. Rao, Ph.D.
 Primary Examiner
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Advisory Action

Claims 31-122 are now currently pending in this application.

Applicant's amendment and arguments filed on 7-16-07 has been considered but NOT ENTERED, as it raises new issues and requires the Examiner to institute at least one new rejection. The amendment has not been entered for the following reasons;

In response to the previous Office action, applicants have NOT made all the amendments either to the specification or to the claims as suggested by the Examiner. While applicants have indeed amended the first line of the specification updating the relationship information, they have traversed the objections made to the figures, figure description and sequence identities in the figures and claims. In response to the objection to specification for not updating the relationship information, applicants traverse and argue that on both the Filing Receipt of April 12, 2004, and the corrected Filing Receipt of April 27, 2004, the patent number of the parent application (08/841,636) has been entered as Pat. No. 6,723,549 and furthermore, on the face page of the published application (U.S. Pub. No.: US2004/0142444 A1), the parent application (No. 08/841,636) and its updated patent number (6,723,549) are displayed under the section of "Related U.S. Application Data." While that may be so applicants, in addition are required to update the relationship information in the first line of the specification. Therefore the objection was not improper. Nevertheless, applicant's traversal is rendered moot since they have now updated the first line of the specification, even though said amendment has not yet been entered.

Next, with reference to the objections to the drawings, applicants traverse the same arguing that the respective SEQ ID NOs are fully identified in the preliminary amendment filed on February 20, 2004 and were reviewed by the previous Examiner. Applicants argue that

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Figures 19A and B correspond to SEQ ID NOs: 30 and 31; Figures 21A, B, and C correspond to SEQ ID NOs: 32 and 33; Figures 23A, B, and C correspond to SEQ ID NOs: 34 and 35; and Figure 27 corresponds to SEQ ID NOs: 36 and 37 and that these amendments were made under the sections of "Brief Description of the Figures" and "Detailed Description of the Preferred Embodiments" of the specification (pages 4-5 of the preliminary amendment, filed February 24, 2004). Examiner agrees that applicants had indeed filed the above amendment. However, that amendment is/was deficient for the following reason. As can be seen in figure 23, for example, (because this is the figure that is recited in the claims as well), there are two different sequences, one is the polynucleotide and the other is the amino acid sequence. Thus figure 23 A-C has TWO sequences. However, the amendment of 2-4-2004 (specifically page 4) reproduced here for applicant's convenience fails to provide the sequence identity for the amino acid sequence which is indeed referred to in claim 31. The amino acid sequence is neither numbered (i.e., as amino acid 1- ____) nor provided a SEQ ID NO. It is in this regard that Examiner urged

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#439 corresponds to SEQ ID NO: 6; fr 9 corresponds to SEQ ID NO: 7; fr 14 corresponds to SEQ ID NO: 8; fr 16 corresponds to SEQ ID NO: 9; fr 17 corresponds to SEQ ID NO: 10; fr 28 corresponds to SEQ ID NO: 11 and fr 30 corresponds to SEQ ID NO: 12.

Please amend the paragraph beginning on page 7, line 28, as follows:

Figure 19 (A and B) shows the DNA sequence of the 20K-cellulase gene (SEQ ID NO: 30). The arrow indicates the predicted signal peptidase processing site.

Please amend the paragraph beginning on page 8, line 4, as follows:

Figure 21 (A and B) (A, B and C) shows the DNA sequence of the 50K-cellulase gene (SEQ ID NO: 32). The arrow indicates the predicted signal peptidase processing site.

Please amend the paragraph beginning on page 8, line 9, as follows:

Figure 23 (A and B) (A, B and C) shows the DNA sequence of the 50K-cellulase B gene (SEQ ID NO: 34). The arrow indicates the predicted signal peptidase processing site.

Please amend the paragraph beginning on page 8, line 16, as follows:

Figure 27 shows the DNA sequence of the protein-with-CBD cellulase gene (SEQ ID NO: 36) in pALK1230.

Please amend the paragraph beginning on page 18, line 3, as follows:

A nucleic acid molecule encoding a polypeptide having the enzymatic activity of a cellulase, selected from the group consisting of:

(a) nucleic acid molecules encoding a polypeptide comprising the amino acid sequence as depicted in Figure 19 (SEQ ID NO: 31) or 21 (SEQ ID NO: 33);

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applicants to provide appropriate SEQ ID NO to the amino acid sequence in figure 23 A-C. The same deficiency is seen in figures 19, 21, 27. Since claim 31 refers figure 23 with respect to the claimed amino acid sequence, it is all the more important that applicants provide both the amino acid numbering as well as its appropriate SEQ ID NO. Without such an amendment it is impossible for the examiner to conclude that the amino acid sequence recited in figure 23 A-C and SEQ D NO:35 of the sequence listing are one and the same. Therefore, Examiner continues to maintain the objection.

Entry of the above amendment would also raise a new issue. This is because, with the entry of the amendment Examiner will be required to reject all the claims at least under 35 U.S.C. 112, 2nd paragraph due to the indefiniteness of the sequence referred to in figure 23 A-C in claim 31.

Examiner also acknowledges that applicants argument traversing the rejection under 35 U.S.C. 112, 1st paragraph for new matter are persuasive and would have been withdrawn if the amendment was entered.

For all the above reasons, the amendment filed on 7-16-07 has not been entered. In view of the non-entry of the above amendment, all rejections and objections made in the previous Office action are maintained for reasons of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-

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0939. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Manjunath N. Rao, Ph.D.
Primary Examiner
Art Unit 1652

July 24, 2007